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J.R.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/396,531	09/15/99	ADDINGTON	99-1001

014253
JOEL I ROSENBLATT
445 11TH AVENUE
INDIALANTIC FL 32903

QM32/0202

EXAMINER
PIERCE, W

ART UNIT PAPER NUMBER
3711 #10

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/396,531

Applicant
Addington et al

Examiner
William M. Pierce

Group Art Unit
3711



☒ Responsive to communication(s) filed on Oct 10, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-32 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

WILLIAM M. PIERCE
PRIMARY EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims should be amended to remove positive recitations to "the bowling ball" (note claim 1, paragraph c) so as not to imply that the bowling ball is being claimed in combination with the finger shield. Likewise, the scope of claims new claims 16 and 19 are unclear in that one cannot determine if the bowling ball is being claimed in combination with the finger pad shield. While the ball is functionally recited in the preamble, it is positively referred to in the body of the claim. The preamble and the body of the claim must be in harmony. Further, the claim positively recites "the bowler" and "said bowler's finger" implying that such is also being claimed in combination which is improper. Claims 17 and 20 is indefinite since one cannot determine what the range may be. A child is not as strong as an adult. Further the lift produced and the force developed on the finger depends on the technique and method used by a person. Each is individual and techniques would tend to produce a greater "maximum force" than others. For example, the point if the point of release of the ball by a bowler in the arch of the swing of the arm is low the force would be low and if the release point is high the forces due to lift would also be high. The english used in claim 18 is disjointed and one cannot determine the scope of the structure intended to be further limited. Claims 25 and 26 contradict claim 24 such that one cannot determine the scope of the claim.

See above just done

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2. Claims 15, 17, 20, 22 and 23 are further objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

3. Claims 1-5, 9-23 and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowble.

Note marked examiner's marked copy of Fowble included with this action. As to claims 1, 3, 15-23 and 27-31, Fowble shows a finger pad A, having a pad shield means with a first curved surface 1 and a second surface 2 including a contact area at 3. The recitations in paragraph c. are functional and fail to distinguish over Fowble. Further shown by him is a "means for placing" by slipping the finger into the shield and the shield is made of rigid material. As to claim 2, he further shows two side walls terminating in an end at c. The shield is open at c as called by claim 4. At the reference marked 4, he shows a closed end called for by claim 5. As to claims 9, 11 and 27, strap 5 is capable of functioning as a "limit means" and is considered a "raised surface" as called for in claim 10. Reference 6 is considered a "support means" as called for by claim 12-14.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-8 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowble in view of Pratt.

As to claim 6, Pratt shows combining finger inserts with gloves in order to position them on the hand. To have included a glove in combination with the insert shown by Fowble would have been obvious in order to keep hold the insert and to further protect the rest of the hand.

6. Claims 16-21, 27-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Marinese et al.

Claims 16, 19, 31 and 32 are clearly shown. Marinese is inherently capable of from the maximum force developed by a bowler as called for in claims 17, 18 and 20. Marinese is rigid as called for in claim 21. As to claim 27, wall part 3 extends obliquely (col. 2, ln. 66) to limit the depth of insertion of said finger pad shield in the finger hole. Wall part 3 is considered to be a "raised surface as called for in claim 28. Element 7 is considered a support as called for in claim 29. As to claim 30, both the shield and the support can be made from a polymer material.

7. Claim 24-26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marinese in view of Pratt.

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Pratt shows combining finger inserts with gloves in order to position them on the hand. To have included a glove in combination with the insert shown by Marinese would have been obvious in order to keep hold the insert and to further protect the rest of the hand.

8. Applicant's arguments filed 10/10/00 have been fully considered but they are not persuasive.

Applicant's remarks with respect to the Administrative Procedure Act are inappropriate. The basic purposes of the Administrative Procedure Act may be said to have four basic purposes as follows: 1.To require agencies to keep the public currently informed of their organization, procedures and rules (sec.3.) 2.To provide for public participation in the rule making process (see. 4). 3.To prescribe uniform standards for the conduct of formal rule making (sec. 4(b) and adjudicatory proceedings (sec. 5), i.e., proceedings which are required by statute to be made on the record after opportunity for an agency hearing (secs. 7 and 8). 4.To restate the law of judicial review (see. 10). Such has nothing to do with the examination of patents and applicant should not cloud the prosecution by referring to it. Applicant, as a patent professional, should be aware by now that the examination of patents is conducted in accordance with the Manual of Patent Examining Procedure. The examination of applications is covered in chapter 700. If applicant is not familiar with the MPEP, can find a copy on the PTO web site at USPTO.gov. Hence, all of applicant's remarks will be responded to in accordance with the MPEP and not the APA.

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Applicant should note that The legislative history of the APA suggested to the Federal Circuit that "Congress drafted the APA to apply to agencies generally, but that because of existing common law standards and the availability of trial de novo pursuant to §4915 of the Revised Statutes, the predecessor of 35 USC §145, Congress did not intend the APA to alter the review of substantive Patent Office decisions." See 5 USC §559 (emphasis added).

As a result, the Federal Circuit concluded: From this background, we construe §559 as freeing Patent and Trademark Office patentability decisions from judicial review under standards enumerated by §§706(2)(A) (arbitrary or capricious standard applied to informal agency proceedings) and 706(2)(E) (substantial evidence standard applied to formal agency proceeding), to the extent that a statutory or common law standard was a more searching standard and hence an additional requirement recognized prior to 1947 that has not since been statutorily modified. Thus, the portion of §§559 stating that the judicial review provisions of the Act were not meant to "limit or repeal additional requirements ... recognized by law" is best understood as preserving those standards of judicial review that had evolved as a matter of common law, rather than compelling that all such standards of review be displaced by the new statute. This construction preserves the benefits derived from the symbiotic relationship between judicially constructed common law and congressionally fashioned statutory law in the area of judicial review.

As to *Dickenson v. Zurko*, the case has done nothing to change the way patents are examined as set forth in the Manual for Patent Examining Procedure. The case deals only with limiting the power of the U.S. Court of Appeals for the Federal Circuit (CAFC) to "second guess"

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the USPTO in making patentability judgements, including those concerning obviousness. The Zurko decision involved a disputed non-obviousness decision by the CAFC and as a result of the decision in the case, in the future, the CAFC will be unable to substitute its judgement for that of the USPTO unless the CAFC determines that the USPTO abused its discretion or acted arbitrarily or capriciously in reaching its conclusion of unpatentability.

Applicant's continued reference to the APA and the "lawfulness" of the examiner's grounds for rejection only serve to cloud the issues. As such, applicant's references thereto will not be further addressed.

With respect to claim 15, examiners conclusion is based on the MPEP 2173 and 2173.02 such that the scope of the claim is not clear to inform the public of the boundaries of what constitutes infringement of the patent. While it is true that a claim may be written as a means plus function under 112, 6th paragraph, that does not mean that the scope of the claim can be indefinite. First claim 15 recites that the shield means is "made to substantially resist deformation". How one makes something to "resist deformation is vague and indefinite. One cannot even determine if the device deforms under a force or not. Further example of the problem with the claim is that it cannot be determined if it is the material or the structure of the device that allows it to resist deformation. Two of a same device, one made of foam rubber and the other of steel, can both be said to "substantially resist deformation". While applicant considers examiners statement "vague and ambiguous", examiner has assumed applicant's representative had a basic understanding for the requirements of 112, second paragraph as

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outlined in the MPEP. However, it is apparent that the applicant is confused by his own self developed "APA standard" the patent prosecution.

To say that claim 15 is written as a "means plus function" is in error since no clear statement of function exists. The claim is narrative and only recites that the shield is "made to" resist deformation. The claim must positively recite the structure as required under 112, 2nd paragraph. Lastly, "the fact that a particular mechanism . . . is defined in functional terms is not sufficient to convert a claim element containing that term into a 'means for performing a specified function' within the meaning of section 112(6)." Greenberg, 91 F.3d at 1583, 39 USPQ2d at 1786 ("detent mechanism" defined in functional terms was not intended to invoke 35 U.S.C. 112, sixth paragraph).

Claim 15 is not a means plus function claim as referred to in 35 U.S.C. 112, sixth paragraph. Claim 15 is a narrative recitation of making the device for an intended use (i.e. "made to substantially resist deformation") While applicant continues his remarks by discussing the description of the "maximum force" in the specification and continues to assert that the claim is a means plus function as allowed in 112 6th paragraph examiner cannot agree. He wrongly states as a result of this description, "the functional limitation expressed in Claim 15 is on a "finger pad shield means," "adapted to spread said force of said bowling ball..." However, 35 U.S.C. 112, sixth paragraph states that an "element in a claim" may be expressed in means plus function. The function of spreading the force is merely narrative and descriptive of the whole finger shield device and does nothing to render the claim definite or permissible under 112, 6th paragraph. In

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short, merely stating what “something does” does is not definite if no clear structure can be determined.

As to Fowble, claim 1 is not a “means plus function claim” as applicant states at the top of his pg. 15. The 112, 6th paragraph allows for “an element” in a claim to be recited as a means plus function. However, this argument is moot since Fowble is applied under 102 and the MPEP states that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). While it is clear that intended use recitations and other types of functional language cannot be entirely disregarded. In an apparatus such as a finger shield, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As state in the previous office action, the functional statements of paragraph c. fail to distinguish over the art since the applied art is capable of performing the intended use of protecting the finger while bowling and spreading out the force applied by the finger to the bowling ball.

Applicant’s continued reference to the function of his finger shield as spreading the force does nothing to distinguish over the art of “finger protectors” in general. Supporting and spreading the force to protect a finger is rudimentary to their purpose. Note that merely claiming

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a property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best ,>562 F.2d 1252, 1254,<195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 with regard to inherency.

Applicant continues to state that examiners statement that "the recitations in paragraph c. are functional and fail to distinguish over Fowble" is improper. However, applicant chooses to ignore the MPEP and again offer clouded arguments pertaining to an APA Standard he has devised. Note MPEP 2114 pertaining to apparatus and article claims and functional language used therein (for a discussion of case law which provides guidance in interpreting the functional portion of means - plus - function limitations see MPEP § 2181 - § 2186). It is held that apparatus claims must be structurally distinguishable from the prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danley, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does ."(emphasis in original) Hewlett - Packard Co . v. Bausch & Lomb Inc ., 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Further the manner of operating the device does not differentiate the apparatus from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged

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in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

Further applicant insists on referring to the function of applying force to a bowling ball. The mere intent of using his finger device on a bowling ball does not distinguish it over the art of record. MPEP 2115 discusses the material or article worked upon by apparatus. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault , 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young , 25 USPQ 69 (CCPA 1935) (as restated in In re Otto , 136 USPQ 458, 459 (CCPA 1963).

In re Casey , 152 USPQ 235 (CCPA 1967), an apparatus claim recited "A taping machine comprising a supporting structure, a brush attached to said supporting structure, said brush being formed with projecting bristles which terminate in free ends to collectively define a surface to which adhesive tape will detachably adhere, and means for providing relative motion between said brush and said supporting structure while said adhesive tape is adhered to said surface." An obviousness rejection was made over a reference to Kienzle which taught a machine for perforating sheets. The court upheld the rejection stating that "the references in claim 1 to adhesive tape handling do not expressly or impliedly require any particular structure in addition to

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that of Kienzle." The perforating device had the structure of the taping device as claimed, the difference was In the use of the device, and "the manner or method In which such machine is to be utilized is not germane to the issue of patentability of the machine itself.").

Further a mere recitation of what something "does" is not sufficient to distinguish the device from the prior art if the prior art is capable of performing that function. The distribution of forces over a larger area is rudimentary to finger protectors In general. This protects the finger from injury when a force is continually applied to a single small area of the finger to cause a bruise or blister or to spread the force along the finger to give the finger support.

As stated above, the intended use of applicant's invention to pick up bowling balls does not distinguish it from Fowble since intended operation are of no significance In determining patentability of the apparatus claim." Ex parte Thibault , 164 USPQ 666, 667 (Bd. App. 1969).

As to claims 9, 10 and 11 applicant has not shown where the strap 5 is not capable of functioning as a "limit means" as set forth In the previous office action. It is held that apparatus claims must be structurally distinguishable from the prior art. Claims directed to apparatus must be distinguished from the prior art In terms of structure rather than function. In re Danley, 120 USPQ 528, 531 (CCPA 1959). As such, the intended function and use with a bowling ball do nothing to distinguish over Fowble.

Applicant argues again the application of Pratt base on intend use. As set forth above, the combination known to finger protectors meets all the structure of the claimed invention. The intended use is not considered to distinguish over the applied art of record.

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A rejection of claims 16-31 is set forth above

The declarations of R. A. Addington and W.R. Addington are noted for their recitations teaching knowledge In the art of bowling and their understanding of the claimed invention. However, such fails to set forth facts that would overcome the applied grounds of rejection. The remarks made pertain to the use of the finger shield and not how the structure is different and critical when contrasted with the prior art.

9. Applicant's amendment necessitated the new ground(s) of rejection presented In this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth In 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (703) 308-3551.


WILLIAM M. PIERCE
PRIMARY EXAMINER